



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,945	07/10/2000	Tomoo Tsunenari	37B.P61	9915

5514 7590 12/04/2002

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,945

Applicant(s)

TSUNENARI, TOMOO

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-6, 8, 10-13, 15-18, and 22 are rejected under 35 USC 102(e) as being anticipated by Junger, patent number 6,085,172.**

Junger teaches all the limitations of Claims 1-6, 8, 10-13, 15-18, and 22. For example, Junger discloses a system and method for efficient handling of product return transactions comprising at least two computers, a web server and a client computer, using the Internet, web interfaces, and email to effect consumer product returns through retailers to manufacturers, to distributors, or a regional

retailer location (please see at least abstract; Fig. 2 (21, INTERNET, 23); col. 1, line 15 through col. 5, line 23). Junger teaches collecting product serial number information to uniquely identify returned product, a database for storing information, identifying destination locations, supplying a description of the returned product, and an operatively connected printer that prints shipping labels from the client computer (see at least Fig. 2 (216); col. 2, lines 14-38; col. 8, lines 50-54). Junger further teaches product return transportation, a truck or other means of transportation, for moving returned product from retailer locations to a returns processing facility (see at least Fig. 1 Prior Art (7); col. 4, lines 4-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 3. Claims 7, 9, 19, and 20 are rejected under 35 USC 103(a) as being unpatentable Junger, patent number 6,085,172, in view of Official Notice and PR Newswire (PTO-892 Item: U).**

Junger teaches all the above as noted under the 102(e) rejection but does not disclose a returned product being a recyclable product destined for a recycling

facility. This examiner takes the position that the system and method of Junger applies equally to recyclable products eligible for return through a retailer or distributor, i.e. a defective recyclable product would be eligible for return or exchange by most retailers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Junger to include recyclable products as taught by Official Notice, in order to better serve consumers who need to return recyclable products.

Junger and Official Notice teach all the above as noted under the 103(a) rejection but do not disclose laser printer ink cartridges as a recyclable product, and returning a recyclable product to a recycling destination. PR Newswire teaches an interactive web site (www.etcep.com) for participants to recycle inkjet and laser cartridges. PR Newswire further teaches 243 million printer cartridges thrown away each year with an aggregate value of \$550 million, and a recycling program as a way for schools to collect used cartridges to be sent to a recycler, and earn points toward future technology purchases for schools. PR Newswire teaches the interactive web site as allowing participants to perform all functions necessary to return used printer cartridges (see page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Junger and Official Notice to include laser printer ink cartridges as taught by PR Newswire, in order to support environmental programs.

- 4. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Junger, patent number 6,085,172, in view of Gralla (PTO-892, page 2, Item: V).**

Junger teaches all the above as noted under the 102(e) rejection and further teaches collecting information via a web interface, but does not disclose the use of a cookie to pass or collect information from the client. Gralla teaches the use of cookies by Internet web sites to pass and collect information from a web client computer. Gralla teaches cookies as bits of data being deposited on a client's hard disk when visiting the web site, and the cookie being used to convey information to the server. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Junger to use the cookie to transmit information to the client computer as taught by Gralla, in order to make it easier to conduct electronic business with the web server.

- 5. Claim 21 is rejected under 35 USC 103(a) as being unpatentable over Junger, patent number 6,085,172, Official Notice, and PR Newswire (PTO-892 Item: U), as applied to Claim 20 above, and further in view of Katayanagi et al., patent number 6,321,983.**

Junger, Official Notice, and PR Newswire teach all the above as noted under the 103(a) rejection, but do not disclose the use of a chip adapted to a printer cartridge to collect product information. Katayanagi et al. teach an IC chip

storage device that adapts to products to help manage the life cycle of the product, spanning manufacturing through disposal. Katayanagi et al. further teach the device's usefulness to recyclers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Junger, Official Notice, and PR Newswire to include a chip adapted to a product as taught by Katayanagi et al., in order to facilitate efficient product return and recycling processes.

6. Claims 23-27 are rejected under 35 USC 103(a) as being unpatentable over Junger, patent number 6,085,172, in view of Official Notice.

Junger teaches all the above as noted under the 102(e) rejection and further teaches a manufacturer's computer that processes return requests providing a web page but does not teach program code as being implemented throughout the system. This examiner takes the position that computer program code is required for computer-automated tasks as disclosed by Junger, else the method of processing consumer returns via the Internet would not function. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose program code as taught by Official Notice, in order to more fully describe how computers interact with each other to facilitate product returns.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone

number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

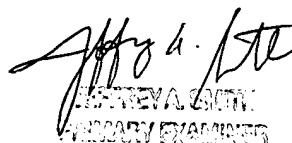
Washington D.C. 20231

or faxed to:

703-305-7687 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RMP
November 29, 2002


JEFFREY A. SCOTT
PRIMARY EXAMINER